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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

Katsuya MURAKAMI, et al.

SERIAL NO: 09/926,317

GROUP: 2834

FILED: October 12, 2001

EXAMINER: BURTON S. MULLINS

FOR: PRODUCT WITH ELECTRICALLY CONDUCTING PORTIONS OF HIGHLY CONDUCTIVE RESINS, AND MANUFACTURE METHOD THEREOF

LETTER

Mail Stop DD
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is an European Office Action for the Examiner's consideration. The reference cited therein has been previously filed on June 10, 2002.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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 20. Jan. 2003
 TBK - PATENT



Application No.
00 917 279.2-2307

Ref.
EP 32251

Date
17.01.2003

Applicant
TOYOTA JIDOSHA KABUSHIKI KAISHA

Communication pursuant to Article 96(2) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 4 months

from the notification of this communication, this period being computed in accordance with Rules 78(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).



17.5.03 ✓

WU04.2.1

KUJAT C
Primary Examiner
for the Examining Division

Enclosure(s): 5 page/s reasons (Form 2906)



Beschleid/Protokoll (Anlage)	Communication/Minutes (Annex)	Notifikation/Procès-verbal (Annexe)
Datum Date Date	17.01.2003	Blatt Sheet Feuille

The examination is being carried out on the **following application documents**:

Text for the Contracting States:

AT BE CH LI CY DE DK ES FI FR GB GR IE IT LU MC NL PT SE

Description, pages:

1-33 as originally filed

Claims, No.:

1-13 as originally filed

Drawings, sheets:

1/13-13/13 as originally filed

The following document (D) is referred to in this communication; the numbering will be adhered to in the rest of the procedure:

FILED 6-10-02 D1: US5229581

Article 82 EPC:

1. The application lacks unity within the meaning of Art. 82 EPC for the following reasons:

1.1 The Examining Division agrees with the objection put forward by the Search Division, which found the following separate inventions or groups of inventions:

- a) invention I1: claims 1-5, 8-10
- b) invention I2: claims 6,7
- c) invention I3: claims 11-13.

See additional information under "lack of unity of invention - sheet B" in the Search Report.



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- 1.2 The "common subject matter" between these groups of inventions is: a product which has electrically conducting portions, which are made of conductive resin.
- 1.3 That common subject matter is not novel in the light of the prior art, see e.g. document D1. Therefore, **lack of unity** (Art. 82 EPC) arises.
- 1.4 Since the applicant has not indicated on which invention searched by the Search Division the further prosecution of the application should be based, **no further examination** of the entire application can be carried out for the time being (cf. the Guidelines, C-III, 7.11). The applicant is asked to state upon which invention further prosecution of this application should be based and to limit the application accordingly. Other inventions are to be excised from the claims, description and drawings if any.
- 1.5 The subject-matter to be excised may be made the subject of one or more **divisional applications**. The divisional applications must be filed directly at the European Patent Office in Munich or its branch at The Hague and in the language of the proceedings relating to the present application, cf. Article 76(1) and Rule 4 EPC. The time limit for filing divisional applications (Rule 25(1) EPC) must be observed.

Article 84 EPC:

- 2.1 The relative term "highly conductive resin" used in claims of **claims 1, 3 and 8 to 10** has no well-recognised meaning and leaves the reader in doubt as to the meaning of the technical features to which it refers, thereby rendering the definition of the subject-matter of said claims unclear (Article 84 EPC). See "Guidelines, C-III, 4.5" for further information.
During the subsequent assessment of novelty and inventive step, the feature "highly" will not be considered.
- 2.2 **Claim 9** does not meet the requirements of Article 84 EPC in that the matter for which protection is sought is not defined. The claim attempts to define the subject-



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matter in terms of the result to be achieved ("said electrically conducting portions are formed .. by pouring the conductive resin into a linear shape", "said parts are so jointed that the end portions ... are made electrically conductive ... to form continuous coils"). Such a definition is only allowable under the conditions elaborated in the Guidelines C-III, 4.7. In this instance, however, such a formulation is not allowable because it appears possible to define the subject-matter in more concrete terms, viz. in terms of how the effect is to be achieved. See e.g. dependent claim 10.

Articles 52 to 56 EPC (for invention I1, notwithstanding the above objections)

- 3.1 Concerning independent product claim 1, document D1 discloses a product which has electrically conducting portions (column 5, line 54, and figures 3 and 4) which are made of a conductive resin (column 5, lines 5-10).
- 3.2 Therefore, the subject-matter of independent **claim 1 lacks novelty over document D1**. Further, documents DE19808178, WO9519034 and US5880669 also disclose the features mentioned in paragraph 3.1 of this communication. In particular, see the passages cited in the Search Report.
- 3.3 Concerning independent method claim 8, document D1 further discloses a method of manufacturing a product having electrically conducting portions, wherein these portions are formed by making a conductive resin fluid into a shape corresponding to the electrically conducting portions and then by causing the conductive resin to solidify (document D1 relates to injection moulding)
- 3.4 Therefore, the subject-matter of independent **claim 8 lacks novelty over document D1**. Further, documents DE19808178, WO9519034 and US5880669 also disclose the features mentioned in paragraph 3.3 of this communication. In particular, see the passages cited in the Search Report.
- 3.5 Dependent **claim 2** does not appear to contain any additional features which, in combination with the features of any claim to which it refers, meet the requirements of the EPC with respect to novelty, since document D1 already



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discloses electrically conducting portions which are coils having an electric path formed helically on an axis for passing an electric current (see figure 3).

Further comments on the claims:

- 4.1 The features of the claims should be provided with **reference signs** placed in parentheses to increase the intelligibility of the claims (Rule 29(7) EPC). This applies to both the preamble and characterising portion (see the Guidelines, C-III, 4.11).
- 4.2 **None of the documents cited in the Search Report discloses or renders obvious coils according to dependent product claim 3 or dependent method claim 10. The incorporation of the features of these claims into amended independent product and method claims would render the subject-matters of such claims novel and inventive.**

Further comments on the description:

5. To meet the requirements of Rule 27(1)(b) EPC, the document D1 should be identified in the description and the relevant background art disclosed therein should be briefly discussed.

Further Action:

- 6.1 The applicant is invited to file new claims which take account of the above comments.
- 6.2 In order to facilitate the examination of the conformity of the amended application with the requirements of Article 123(2) EPC, the applicant is requested to **clearly identify the amendments carried out**, irrespective of whether they concern amendments by addition, replacement or deletion, and to indicate the passages of the application as filed on which these amendments are based.



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If the applicant regards it as appropriate these indications could be submitted in handwritten form on a copy of the relevant parts of the application as filed.